

REMARKS

In the Examiner's February 2, 2005 Office Action, the Examiner stated:

"Applicant also argues, 'none of the cited references, taken individually or together, teach transmitting travel expense data from a hand-held computer to a server via a wireless network.' However, a handheld computer is equivalent to a laptop computer because they impart the same functionality to the user and solve the same problems. Also, travel expenses are functionally equivalent to any other type of expense data transmitted from one computing device to another."

The Examiner then rejected claims 1 – 20 under 35 U.S.C. § 103(a). For example, the Examiner rejected claims 1, 3 – 11, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Belford *et al.* in view of Stone *et al.* The Examiner stated, with respect to claim 1:

"Belford, as shown, discloses the following limitations:

- a) displaying a screen on the hand-held computer that includes a field for receiving travel expense report data (see at least Figures 4-7);
- b) entering travel expense report data into the hand-held computer (see at least paragraph 0005);
- c) displaying a screen on the hand-held computer that includes a field for receiving travel expense item data (see at least Figures 4 – 7);
- d) entering travel expense item data into the hand-held computer (see at least paragraph 0005)."

As the Examiner is aware, in order to establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. MPEP 2143.03 states:

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Applicant respectfully asserts that the Examiner has not met the Examiner's initial burden to establish *prima facie* obviousness of any of the currently pending claims. For example, claim 1 requires, among other things:

1. A method of transmitting travel expense report data and travel expense item data from a hand-held computer to a server comprising:
 - a) displaying a screen on the hand-held computer that includes a field for receiving travel expense report data;
 - b) entering travel expense report data into the hand-held computer;
 - c) displaying a screen on the hand-held computer that includes a field for receiving travel expense item data;
 - d) entering travel expense item data into the hand-held computer;

None of the cited references, taken individually or together, teaches: displaying a screen on a **hand-held** computer that includes a field for receiving **travel** expense report data; entering **travel** expense report data into a **hand-held** computer; displaying a screen on a **hand-held** computer that includes a field for receiving **travel** expense item data; or entering **travel** expense item data into the **hand-held** computer. As is evident from the Examiner's statement, which is presented on the previous page, the Examiner understands that Belford *et al.* provides such teachings. It appears that the Examiner's understanding is based on the Examiner's statement:

“However, a handheld computer is equivalent to a laptop computer because they impart the same functionality to the user and solve the same problems. Also, travel expenses are functionally equivalent to any other type of expense data transmitted from one computing device to another.”

Thus, it appears that the factual basis for the Examiner's statements is that the Examiner understands that “a handheld computer is equivalent to a laptop computer because they impart the same functionality to the user and solve the same problems” and the Examiner understands that “travel expenses are functionally equivalent to any other type of expense data.” Applicant respectfully disagrees with the Examiner's factual bases. If the Examiner has ever attempted to enter an email into a hand-held computer, the Examiner will understand that hand-held computers do not impart the same functionality and solve the same problems as laptop computers. Further, travel expense data is not functionally equivalent to other expense data. Travel expense data contains a number of data items that are not present in non-travel expense data. For example, non-travel expense data would not include lodging data items.

Applicant has performed an electronic search of the MPEP for the phrase “functionally equivalent” to determine the legal basis for the Examiner’s statements. Applicant has not located a single instance of that phrase in the MPEP. Applicant is likewise not aware of any statute or judicial ruling that supports the proposition that one can establish *prima facie* obviousness of a claimed invention because the prior art is purported to be “functionally equivalent.” If the Examiner is aware of any such statute or judicial ruling, please provide same to Applicant.

Applicant understands that in order to establish *prima facie* obviousness of a claimed invention, “all claim limitations must be taught or suggested in the prior art.” See MPEP 2143.03. None of the cited prior art teaches or suggests **all** the claim limitations. More specifically, the cited prior art does not teach or suggest displaying a screen on a **hand-held** computer that includes a field for receiving **travel** expense report data. Similarly, the cited prior art does not teach or suggest: entering **travel** expense report data into a **hand-held** computer; displaying a screen on a **hand-held** computer that includes a field for receiving **travel** expense item data; or entering **travel** expense item data into the **hand-held** computer. Thus, the Examiner has not met the Examiner’s initial burden of “**factually supporting** a *prima facie* conclusion of obviousness.” See MPEP 2142. (emphasis added).

Applicant also understands that “all words in a claim must be considered in judging the patentability of [a] claim against the prior art.” See MPEP 2143.03. Applicant respectfully submits that the Examiner is not considering the express limitations that a “hand-held computer” perform a number of claimed operations on “travel expense” data when judging the patentability of Applicant’s claims. In effect, the Examiner has improperly ignored those limitations. As a result, the Examiner has not met the Examiner’s initial burden of “**factually supporting** a *prima facie* conclusion of obviousness.” See MPEP 2142. (emphasis added).

Just as the Examiner has not met the Examiner’s initial burden of factually supporting a *prima facie* conclusion of obviousness for independent claim 1, the Examiner has not met the Examiner’s initial burden of factually supporting a *prima facie* conclusion of obviousness for independent claims 15 and 16. For example, claim 15 requires a hand-held computer to perform a number of operations on travel expense data. As discussed above, the cited prior art does not disclose a hand-held computer performing the claimed operations on travel expense data. Similarly, claim 16 requires a program storage device containing instructions that when executed

by a hand-held computer causes the hand-held computer to perform a number of operations on travel expense data. As discussed above, the cited prior art does not disclose a hand-held computer performing the claimed operations on travel expense data.

Thus, Applicant believes that each independent claim is allowable. As a result, Applicant believes that all dependent claims are likewise allowable.

CONCLUSION

It is submitted that the present application is presently in form for allowance. Such action is respectfully requested.

Respectfully submitted,

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